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OFFICE OF PETITIONS

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In re Application of	:	
Hitoshi Fukushima et al.	:	
Application No. 10/006,794	:	DECISION ON PETITION
Patent No. 7,098,145	:	PURSUANT TO
Filed: December 4, 2001	:	37 C.F.R. § 3.81(B)
Issue Date: August 29, 2006	:	
Attorney Docket Number: 9319S-	:	
000311/CPA	:	
Title: FABRICATION OF SELF-	:	
ASSEMBLED MONOLAYERS	:	

This is a decision on the "PETITION TO STATE THE NAME OF SECOND ASSIGNEE ON ISSUED PATENT," filed July 20, 2007, which is properly treated as a petition pursuant to 37 C.F.R. § 3.81(b)¹, to correct the Assignee's information on the Issue Fee Transmittal Form PTOL-85(b).

This petition is **DISMISSED AS INAPPROPRIATE**.

Petitioner states that an error appears on the face of the patent, as the Assignee (Cambridge University Technical Services Limited of the U.K.) was omitted.

The present request pursuant to 37 C.F.R. § 3.81(b) was accompanied by a request for a certificate of correction, a draft certificate of correction, the processing fee, and the certificate of correction fee.

Petitioner has made the following assertions:

¹ See Official Gazette, June 22, 2004.

1. there are two assignees that are involved with this patent;
2. prior to the payment of the issue fee, an assignment document was sent to the Office for recording, and the Office failed to record the second assignee, Cambridge University Technical Services Limited (this document was received in the Office on July 17, 2002);
3. this error was corrected via an unspecified means on an unspecified date, and;
4. the Office mailed a "corrected notice" on June 7, 2007, listing both Assignees.

The assignment document that was submitted to the Office on July 17, 2002 has been reviewed, and it is clear that it does not constitute an assignment of patent rights to the assignee listed thereon (Cambridge University Technical Services Limited), due to the fact that the field "[n]ame of conveying parties" has been left blank. As such, while it is clear that the individual who prepared this document intended for Cambridge University Technical Services Limited to be the Assignee, **there is no Assignor listed thereon**, and a valid assignment requires both an Assignor and an Assignee. Without an Assignor to convey rights to an Assignee, there can be no conveyance of rights. As such, **the submission of July 17, 2002 does not constitute an assignment** in regards to Cambridge University Technical Services Limited.

In regards to the corrected notice on June 7, 2007, it is noted in passing that MPEP § 301(V)(A) sets forth, *in pertinent part*:

It should be noted that recording of the assignment is merely a ministerial act; it is not an Office determination of the validity of the assignment document nor the effect of the assignment document on the ownership of the patent property. See 37 CFR 3.54 and MPEP § 317.03...

37 C.F.R. § 3.81(b), effective June 25, 2004, reads:

After payment of the issue fee: Any request for issuance of an application in the name of the assignee submitted after the date of payment of the issue fee, and any request for a patent to be corrected to state the name of the assignee, must state that the assignment was submitted for recordation as set forth in 3.11 before issuance of the patent, and must include a request for a certificate of correction under 1.323 of this chapter (accompanied by the fee set forth in 1.20(a)) and the processing fee set forth in 1.17(i) of this chapter.

Since it does not appear that an assignment was submitted for recordation as set forth in 37 C.F.R. § 3.11 before issuance of the patent, this petition is not appropriate.

The certificate of correction fee will be refunded to Petitioner's Deposit Account in due course. The processing fee of \$130.00 will not be refunded, as this petition was not necessitated by any error on the part of the Office.

Telephone inquiries regarding *this decision* should be directed to the undersigned at (571) 272-3225².

/Paul Shanowski/
Paul Shanowski
Senior Attorney
Office of Petitions

² Petitioner will note that all practice before the Office should be in writing, and the action of the Office will be based exclusively on the written record in the Office. See 37 C.F.R. § 1.2. As such, Petitioner is reminded that no telephone discussion may be controlling or considered authority for any further action(s) of Petitioner.